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APR 26 2004

OFFICE OF PETITIONS

In re Application of :
Peter J. Houzego et al. :
Application No. 10/607,721 :
Filed: June 27, 2003 : DECISION ON PETITION
Attorney Docket No. PHAG 100 DIV :
Title: INGESTIBLE DEVICE :

This is a decision on the petition filed September 26, 2003.

On June 27, 2003, the above-identified application was deposited. On September 22, 2003, the Office of Initial Patent Examination (OIPE) mailed a "Notice of Omitted Item(s) in a Nonprovisional Application - Filing Date Granted (notice)", advising applicant that the application appeared to have been deposited without pages 19, 20, 34, and 35 of the specification.

On September 26, 2003, Petitioner submitted a "Response to Notice of Omitted Item(s) in a Nonprovisional Application," along with pages 19, 20, 34, and 35 of the specification and payment of the petition fee. No arguments were made, no evidence was presented, and no mention was made of the desired filing date. As such, Petitioner has not explicitly stated what resolution he seeks.

However, the Petitioner has set forth an attestation that the four pages of the specification which have been enclosed with the instant petition are copies of that which was filed in the parent application.

Although the Petitioner has not revealed what action it is that he wishes the Office to take, it appears that he wishes the missing four pages to be considered constructively present on

filing via an incorporation by reference. A review of the Utility Patent Application Transmittal sheet in the electronic file has shown that the parent application was incorporated by reference.

The Office allows an applicant to rely upon an incorporation by reference of a parent application when a portion of the child application has been inadvertently omitted. It is noted that the application transmittal letter identifies this application as a divisional of prior application No. 09/742,936, and specifically incorporated by reference the disclosure of the prior application.

Section 201.06(c) of the MPEP sets forth, in part:

an applicant may incorporate by reference the prior application by including, in the continuation or divisional application-as-filed, a statement that such specifically enumerated prior application or applications are "hereby incorporated herein by reference." The statement may appear in the specification or in the application transmittal letter. The incorporation by reference statement can only be relied upon to permit the entering of a portion of the prior application into the continuation or divisional application when the portion of the prior application has been inadvertently omitted from the submitted application papers in the continuation or divisional application. The inclusion of this incorporation by reference of the prior application(s) will permit an applicant to amend the continuation or divisional application to include any subject matter in such prior application(s), without the need for a petition provided the continuation or divisional application is entitled to a filing date notwithstanding the incorporation by reference.

(Emphasis added).

If petitioner desires for the examiner to consider the missing four pages which were not submitted as part of the original disclosure, then petitioner may submit these pages via an amendment. Any such amendment will, of course, be reviewed by the examiner for new matter¹. The amendment is not new matter if the substance was a part of the disclosure of the prior application.

For these reasons, the petition is dismissed.

Pages 19, 20, 34, and 35 of the specification, submitted with the instant petition, will not be entered. Should petitioner wish for these pages to be entered, an amendment must be filed.

The original application papers will include only those application papers present on the date of deposit.

¹ See MPEP 608.02(a).

The original application papers will include only those application papers present on the date of deposit. .

The petition fee of \$130.00 will not be refunded, as this petition was not necessitated by any error on the part of the Office.

The Application is being returned to the Office of Initial Patent Examination for further processing with a filing date of June 27, 2003, using only the application papers filed on that date.

After the mailing of this decision, the application will be forwarded to the Office of Initial Patent Examination for further processing.

Telephone inquiries specific to this matter should be directed to the undersigned at (703) 305-0011.



Paul Shanowski
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United States Patent and Trademark Office